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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/547,193	08/29/2005	Mathew Louis Steven Leigh	032553-054	9179
21839	7590	05/16/2008	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				CLAYTOR, DEIRDRE RENEE
ART UNIT		PAPER NUMBER		
1617				
			NOTIFICATION DATE	
			DELIVERY MODE	
			05/16/2008	
			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/547,193	LEIGH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Renee Claytor	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 August 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 8/29/2005.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Objections***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections – 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the recitation "A dermal of topical composition..." is referring to.

### ***Claim Rejections – 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-7 rejected under 35 U.S.C. 102(b) as being anticipated by Frohne (US Pg-Pub 2001/0009671).

Frohne teaches cosmetic compositions comprising a panthenol oil regulating agent, a particulate oil-absorbing polymer and a cosmetically acceptable carrier (paragraphs 0024-31). The oil-absorbing polymer has a surface area in the range from about 50 to 500 m<sup>2</sup>/g (paragraph 0037) and is taught in amounts of 0.1 to 10%, which overlaps with part a) of claim 4 (paragraph 0030). The polymer oil-absorbing agent is in the form of a powder, the powder being a combined system of particles and composition comprises hydrophilic components such as propylene glycols (paragraph 0054) in amounts from about 0.1% to about 20% (paragraph 0052), surfactants and lipophilic components such as dimethicone (paragraph 0056) in amounts from about 0.1 to about 25% (paragraph 0057). Examples 1 and 2 exemplify a composition with the above ingredients in amounts that fall within the ranges taught in claims 2-4 and 6-7. It is taught that the composition is useful in retarding the appearance of oil and/or shine on the skin (paragraphs 0018 and 0022).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 5-6 rejected under 35 U.S.C. 102(e) as being anticipated by Withiam et al. (US Pg-Pub 2003/0235597).

Withiam et al. teach cosmetic fluid compositions comprising a sebum-absorbing calcium silicate (paragraph 0007). The calcium silicate particles act as absorbents to absorb the wax and lipid-based sebum material and provides effective, long-lasting facial cosmetic coverage (paragraph 0020). The surface area of the calcium silicates is around 150 m<sup>2</sup>/g to 600 m<sup>2</sup>/g (paragraph 0025). Suitable ingredients in the composition include lipophilic agents such as dimethicones (paragraph 0040), hydrophilic components such as propylene glycol (paragraph 0042) and surfactants such as phosphates (paragraph 0036).

It is respectfully pointed out that a recitation of an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus the intended use recited in claim 6, namely that the composition absorbs oils and hydrates skin, scalp and hair is not afforded patentable weight.

### ***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-7 rejected under 35 U.S.C. 103(a) as being unpatentable over De Graaf et al. (WO 98/48774) in view of Duffy et al. (US Patent 5,415,861).

De Graaf et al. teach a cosmetic composition for topical application comprised of agglomerated silica and/or talcum and hydrophilic components such as polymethacrylate copolymers containing glycerol, lipophilic components such as dimethicone (page 4, lines 16-28 - page 5, lines 1-5) and surfactants (page 11, lines 1-9). The formulations may be formulated into creams for topical application (page 6, lines 17-19). The agglomerated silica and/or talcum is present at 0.1 to 10% by weight of the composition, the hydrophilic component is present in an amount of 0.0001 to 20%, the lipophilic component is present in an amount of 0.1 to 10% which overlaps with that of claims 3-4 and 7. The Experimental section beginning on page 7 outlines experiments in which creams were applied to the face to combat oiliness.

De Graaf et al. does not teach that the agglomerated silica and/or talcum has a surface area greater than 40 m<sup>2</sup>/g.

Duffy et al. teach topical compositions that include active ingredients that absorb and remove oil (Col. 3, lines 12-17). The active agents comprise silica which includes Cab-O-Sil (an agglomerated silica) with a specific surface area of 380 m<sup>2</sup>/g.

Accordingly, it would be obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of De Graaf et al. which teach topical compositions comprised of an agglomerated silica as an oil absorbing agent with the teachings of Duffy et al. who also teach agglomerated silicas with high surface areas as

oil absorbing agents in topical compositions. One would be motivated to use agglomerated silicas with high surface areas because Duffy et al. teaches that the high surface area is expected to increase oil absorbency (Col. 4, lines 15-16).

Claims 3-4 and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Withiam et al. (US Pg-Pub 2003/0235597).

Withiam et al. teach cosmetic fluid compositions comprising a sebum-absorbing calcium silicates as discussed above.

Withiam et al. does not teach weight ranges that meet or overlap with those presently claimed.

However, Withiam does teach that the compositions comprise about 0.1 to about 25 wt % of the calcium silicate, which overlaps with that in claims 2 and 4 (paragraph 0020). Suitable ingredients in the composition include lipophilic agents such as dimethicones which are included in amounts of about 0.1 to about 10% by weight (paragraph 0040), hydrophilic components such as propylene glycol in amounts from 0.5 to 50% (paragraph 0042) and surfactants such as phosphates in amount of about 0.1 to about 10% by weight (paragraph 0036).

Furthermore, it is obvious to vary and/or optimize the amount of calcium silicate, lipophilic, hydrophilic and surfactant provided in the composition, according to the guidance provided by Withiam et al., to provide a composition having the desired properties such as the desired percentages of each component and one would be motivated to do this in an effort to formulate a suitable composition for absorbing oil and

hydrating the skin. It is noted that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

***Conclusion***

No claims are allowed.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is (571)272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

/SREENI PADMANABHAN/  
Supervisory Patent Examiner, Art Unit 1617